

## **REMARKS**

### **I. STATUS OF APPLICATION**

Claims 26-35 have been canceled. Claims 36-40 have been added. Accordingly, claims 1-25 and 36-40 are pending in the present Application.

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of co-pending U.S. Patent Application 11/072,382 ("the '382 Application").

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting, as being unpatentable over claims 1-25 of co-pending U.S. Patent Application 11/524,367 ("the '367 Application") in view of U.S. Patent 6,840,836 to Siverson ("Siverson").

Claims 1-25 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

Claims 1-25 stand rejected under 35 USC § 103(a), as being unpatentable over U.S. Patent 6,372,323 to Kobe *et al.* ("Kobe") in view of Siverson and U.S. Patent 6,960,272 to Tokas *et al.* ("Tokas").

### **II. RESTRICTION REQUIREMENT**

The Office has required restriction between a film, set forth in claims 1-25, and a method, set forth in claims 26-36. The present Office Action indicates that, on 29 September 2005, a provisional election without traverse to prosecute the alleged invention set forth in claims 1-25 was made by Mr. James Walton. The election of the

alleged invention set forth in claims 1-25 is hereby affirmed. Applicant's election, however, of a particular alleged "invention" is not an acquiescence in the propriety of the restriction or in the accuracy in the determination and/or identification of the alleged "invention" in the application.

Applicant respectfully submits that new claims 36-40 are drawn to a film and, thus, should be examined on the merits.

### **III. PROVISIONAL DOUBLE PATENTING REJECTIONS**

#### **A. Provisional rejection of claims 1-25 over claims 1-6 of the co-pending '382 Application**

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of the co-pending '382 Application.

Applicant notes the provisional rejection, which will be taken up in due course upon the allowance of either the present Application or the '382 Application.

#### **B. Provisional rejection of claims 1-25 over claims 1-25 of the co-pending '367 Application in view of Siverson**

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting, as being unpatentable over claims 1-25 of the co-pending '367 Application in view of Siverson. "[T]he analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection."<sup>1</sup>

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<sup>1</sup> MPEP 804.

The present Application is a National Stage Application under 35 USC § 371 proceeding from International Patent Application PCT/US2004/006552 that claims priority to U.S. Provisional Patent Application 60/500,311 ("the '311 Application"). The '311 Application has a filing date of 4 September 2003, which is the effective filing date for the present Application. Siverson has a filing date of 8 December 2003, which is after the effective filing date of the present Application. ***Siverson, therefore, is not available as prior art in the present Application.***

Moreover, Applicant respectfully asserts that Siverson is outside the scope and content of the prior art, for at least the reasons set forth below concerning the 35 USC § 103(a) rejection of claims 1-25 over Kobe, Siverson, and Tokas.

Accordingly, Siverson cannot be properly combined with any other reference to render the present invention obvious. It is, therefore, respectfully requested that the provisional rejection on the ground of non-statutory obviousness-type double patenting, as being unpatentable over claims 1-25 of the '367 Application in view of Siverson, be reconsidered and withdrawn.

#### **IV. 35 USC § 112 REJECTIONS**

Claims 1-25 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

##### **A. The term "thin" in claim 1 is not indefinite**

The Office alleges:

*The term "thin" in claim 1 is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one*

*of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a “thin” film or layer, i.e., what dimensions are considered to be thin.*<sup>2</sup>

Applicant respectfully asserts that acceptability of the language used in a claim depends upon whether a person having ordinary skill in the art would understand what is claimed, in light of the Specification. Regarding the term “thin,” the present Specification states:

*Plastic film substrate 15 is a thin, flexible film, preferably a clear film about 0.002 inches thick, that forms and provides a flexible durable, dimensionally stable substrate.*<sup>3</sup>

Given this teaching, Applicant respectfully asserts that the Specification provides a standard for ascertaining the requisite degree and that a person having ordinary skill in the art would be “reasonably apprised” of the scope of the invention, contrary to the Office’s allegation.

In *Modine Manufacturing Co. v. U.S. International Trade Commission*,<sup>4</sup> the invention related to a condenser for use in automotive air conditioning. The claims at issue recited “flow paths being of *relatively small hydraulic diameter*.”<sup>5</sup> The Federal Circuit interpreted this limitation, in light of the specification, to be definite and to mean a hydraulic diameter in the range of about 0.015 to 0.040 inch.<sup>6</sup> With some modification for the involved technologies, the reasoning applies directly to the present case. The term “thin” is not indefinite in light of the teaching of the present Specification.

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<sup>2</sup> *Detailed Action*, p. 5, ll. 6-10.

<sup>3</sup> *WO 2005/026434*, p. 6, ll. 7-9.

<sup>4</sup> *Modine Mfg. Co. v. United States Int’l Trade Comm’n*, 75 F.3d 1545, 37 USPQ2d 1609 (Fed. Cir.), *cert. denied*, 518 U.S. 1005 (1996).

<sup>5</sup> *Modine Mfg. Co.*, 37 USPQ2d at 1611 (emphasis in original).

<sup>6</sup> *Modine Mfg. Co.*, 37 USPQ2d at 1615.

It is, therefore, respectfully requested that the rejection of claim 1 under 35 USC § 112, second paragraph, in which the term “thin” is alleged to be indefinite, be reconsidered and withdrawn.

**B. The term “low” in claim 1 is not indefinite**

The Office alleges:

*The term “low” in claim 1 is a relative term which renders the claim indefinite. The term “low” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a “low” durometer, i.e., what values are considered to be low.<sup>7</sup>*

As discussed above, Applicant respectfully asserts that acceptability of the language used in a claim depends upon whether a person having ordinary skill in the art would understand what is claimed, in light of the Specification. Regarding the term “low,” the present Specification states:

*Silicone elastomer 13 is formed to have a low-durometer, i.e., less than 40 on the Shore A scale.<sup>8</sup>*

Given this teaching, Applicant respectfully asserts that the Specification provides a standard for ascertaining the requisite degree and that a person having ordinary skill in the art would be “reasonably apprised” of the scope of the invention, contrary to the Office’s allegation. The discussion above concerning *Modine Manufacturing Co. v. U.S. International Trade Commission* applies equally to the Office’s allegation that the term “low” is indefinite.

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<sup>7</sup> *Detailed Action*, p. 5, ll. 11-15.

<sup>8</sup> *WO 2005/026434*, p. 6, ll. 17-18.

It is, therefore, respectfully requested that the rejection of claim 1 under 35 USC § 112, second paragraph, in which the term “low” is alleged to be indefinite, be reconsidered and withdrawn.

**C. The term “smooth” in claim 7 is not indefinite**

The Office alleges that the term “smooth” in claim 7 renders claim 7 indefinite. The present Specification teaches “[s]urface 19 is preferably formed to have a surface texture or pattern, as shown, although surface 19 may alternatively be matte or smooth.”<sup>9</sup> Thus, Applicant respectfully asserts that one having ordinary skill in the art would appreciate a “smooth” surface to be a surface absent of such texture or pattern.

It is, therefore, respectfully requested that the rejection of claim 7 under 35 USC § 112, second paragraph, in which the term “smooth” is alleged to be indefinite, be reconsidered and withdrawn.

**D. The term “heavily” in claim 8**

The Office alleges that the term “heavily” in claim 8 renders claim 8 indefinite. The term “heavily” is deleted from claim 8 in this paper to advance prosecution. Applicant’s amendment of claim 7, however, is not an acquiescence in the propriety of the Office’s rejection.

It is, therefore, respectfully requested that the rejection of claims 1-25 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention, be reconsidered and withdrawn.

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<sup>9</sup> *Specification*, p. 5, l. 31, through p. 6, l. 1.

## **V. 35 USC § 103 REJECTIONS**

Claims 1-25 stand rejected under 35 USC § 103(a), as being unpatentable over Kobe in view of Siverson and Tokas. Applicant respectfully asserts that the combination of Kobe, Siverson, and Tokas fails to render the present invention obvious, as discussed below.

### **A. Siverson is not prior art in the present Application**

As noted above concerning the provisional, non-statutory, obviousness-type double patenting rejection of claims 1-25 over claims 1-25 of the co-pending '367 Application in view of Siverson, Siverson is not available as prior art in the present Application, as the effective filing date of the present Application predates the filing date of Siverson.

Accordingly, it is respectfully requested that the 35 USC § 103(a) rejection over Kobe, Siverson, and Tokas be reconsidered and withdrawn.

### **B. Claims 1-25 are further allowable over the cited references, as Siverson is outside the scope and content of the prior art**

Claims 1-25 require “a thin layer of silicone elastomer having a low durometer.” Amended claim 3 further requires the durometer of the silicone elastomer to be “less than 30 on the Shore A scale.” The Office admits on the record that “Kobe fails to disclose that the silicone elastomer has a low durometer, more specifically less than 40 on the Shore A scale.”<sup>10</sup> The Office, however, alleges that “Siverson discloses a flexible disk...made of silicone with a Shore A durometer hardness between 20 and 60, but most preferably about 40.”<sup>11</sup>

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<sup>10</sup> *Detailed Action*, p. 6, ll. 22-23.

<sup>11</sup> *Detailed Action*, p. 7, ll. 1-2.

Even if the filing date of Siverson predated the effective filing date of the present Application, Applicant respectfully asserts that Siverson is from a non-analogous art and, thus, is not available as prior art in the present Application. A reference can be asserted against the claimed invention under §103 only if (1) it is within Applicant's field of endeavor, or (2) is reasonably pertinent to the problem facing Applicant even though not within Applicant's field of endeavor.<sup>12</sup>

Siverson relates to a flexible flying disk as opposed to any kind of thin film silicone elastomer. Thus, Siverson can be within the scope and content of the prior art only if it is “reasonably pertinent” to Applicant’s invention:

*A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the inventor and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have less motivation or occasion to consider it.*<sup>13</sup>

In the present case, the hardness of Siverson’s flying disk addresses a very different problem for a very different purpose. Siverson states its intent and interest directly in the patent:

*The cured material in the described disk form is extremely resilient, and has nearly infinite memory. That is,*

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<sup>12</sup> *In re Clay*, 23 USPQ2d (BNA) 1058, 1060 (Fed. Cir. 1992) (reversing Board holding of obviousness).

<sup>13</sup> *Clay*, 966 F.2d 656 at 659.



*the disk will go back to its original configuration even after being crushed in a folded, wadded, or rolled condition....Thus, the disk can be stuffed into a pocket, crushed in a suitcase, bent and stretched in a toy box, but will always return to its original shape.*<sup>14</sup>

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*Also, this material is non-toxic, and is very heat resistant, and can be formed into a safe, fun toy that can be thrown indoors or out without substantial fear that it will damage a struck object. For example the disk, thrown with a force against a common glass window, will simply deform, absorbing the energy of impact rather than damaging the window.*<sup>15</sup>

Thus, Siverson is concerned with shape memory, toxicity, heat resistance, and energy absorption. None of these are even remote considerations in Applicant's invention.

Thus, practical considerations in operation and structure of the claimed invention, a thin elastomeric film, and Siverson, a flying disk, evidence the distinctiveness of these two fields of endeavor.<sup>16</sup> These distinctions are at least as compelling as, if not more so, than those cited by the courts in *Clay* and *Horn*. Since the reference is directed to a different purpose than the claimed invention, one of ordinary skill in the art "would accordingly have had less motivation or occasion to consider it".<sup>17</sup>

Indeed, the discussion in *Clay* is pertinent to the present case. In addressing the first part of the test for analogous art, the Federal Circuit reasoned:

*The PTO argues that [the reference] and [Applicant's] inventions are part of a common endeavor—"maximizing withdrawal of petroleum stored in petroleum reservoirs." However, [the reference] cannot be considered to be within*

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<sup>14</sup> *Siverson*, col. 3, l. 62, through col. 4, l. 2.

<sup>15</sup> *Siverson*, col. 4, ll. 2-8.

<sup>16</sup> *See Clay*, 23 USPQ2d (BNA) at 1060-61; *In re Horn*, 203 U.S.P.Q. (BNA)969, 971 (C.C.P.A. 1979).

<sup>17</sup> *Clay*, 23 USPQ2d (BNA) 1061.

*[Applicant's] field of endeavor merely because both relate to the petroleum industry....[Applicant's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of the [reference], on the other hand, is the extraction of crude petroleum. The Board clearly erred in considering [the reference] to be within the same field of endeavor as [Applicant's].*<sup>18</sup>

This reasoning reads directly on the present case with only slight modification for the technologies involved. With respect to the second part of the test, the Federal Circuit, after a discussion of the two inventions, held:

*A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies. The Board's finding to the contrary is clearly erroneous.*<sup>19</sup>

Again, with some modification for the involved technologies, the reasoning applies directly to the present case. Siverson is outside the scope and content of the prior art applicable to Applicant's invention. Thus, Siverson cannot be properly combined with Kobe and Tokas to render the present invention, as set forth in claims 1-25, obvious.

**C. Claim 2 is separately allowable over the cited references, as Tokas teaches away from the claimed invention**

Claim 2 requires the plastic film, on which the silicone elastomer is disposed, to have "a surface energy of less than about 40 Dynes/cm." The Office relies on Tokas to teach "that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm...."<sup>20</sup> However, "[i]t is well settled that a prior art reference is

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<sup>18</sup> *Clay*, 23 U.S.P.Q.2d (BNA) at 1060.

<sup>19</sup> *Clay*, 23 U.S.P.Q.2d (BNA) at 1061.

<sup>20</sup> *Detailed Action*, p. 7, ll. 12-14.

relevant for *all* that it teaches one of ordinary skill in the art.”<sup>21</sup> Regarding the portion of Tokas cited by the Office, Tokas teaches:

*Pre-cured and cured SANTOPRENE® TPE is particularly difficult to adhesively bond because it has a polyolefinic thermoplastic continuous matrix (similar to polyolefinic materials like polyethylene and polypropylene) that has an especially low surface energy of 28-30 dynes/cm....*<sup>22</sup>

Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention could not have been motivated to modify Kobe’s article to include a low surface energy film because Tokas teaches away from such a combination. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.<sup>23</sup> For at least this additional reason, claim 2 is allowable over Kobe, Siverson, and Tokas.

**D. Regarding claims 6 and 8-10, the limitation “polished” is not a method limitation and the cited references fail to disclose or suggest a silicone elastomer having a polished surface finish**

Claim 6, from which claims 8 and 9 depend, and claim 10 require the silicone elastomer to have “a polished surface finish.” The Office alleges that “the limitation ‘polished’ is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results.”<sup>24</sup> Applicant respectfully traverses the Office’s allegation because the limitation “polished” is not a method limitation but is, instead, structural in nature.

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<sup>21</sup> *In re Fritch*, 23 U.S.P.Q.2d (BNA) 1780, 1782 (Fed. Cir. 1992).

<sup>22</sup> *Tokas*, col. 2, ll. 15-20.

<sup>23</sup> *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

<sup>24</sup> *Detailed Action*, p. 8, ll. 3-5.

In *In re Garnero*,<sup>25</sup> the CCPA held certain limitations to be structural rather than process limitations. Claim 1 in *Garnero* recited:

*A composite, porous, thermal insulation panel characterized by dimensional stability and structural strength consisting essentially of expanded perlite particles which are interbonded one to another by interfusion between the surfaces of the perlite particles while in a pyroplastic state to form a porous perlite panel.*<sup>26</sup>

On appeal to the CCPA, the solicitor for the Patent Office argued that the limitation “interbonded one to another” was a process limitation that was not a patentable distinction over the prior art. The CCPA disagreed and held the limitation to be a structural limitation, stating that:

*it seems to us that the recitation of the particles as “interbonded one to another by interfusion between the surfaces of the perlite particles” is as capable of being construed as a structural limitation as “intermixed,” “ground in place,” “press fitted,” “etched,” and “welded,” all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations....*<sup>27</sup>

This reasoning reads directly on the present case with only slight modification for the technologies involved. A “polished surface finish” is a structural limitation of the silicone elastomer, not merely the result of a process for making the silicone elastomer. Accordingly, “polished surface finish” must be given patentable weight.

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<sup>25</sup> *In re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969).

<sup>26</sup> *Garnero*, 162 USPQ at 222.

<sup>27</sup> *Garnero*, 162 USPQ at 223. See also *Hazani v. United States Int’l Trade Comm’n*, 12 F.3d 1473, 44 USPQ2d 1358, 1363 (Fed. Cir. 1997) (citing *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971)):

*Hazani argues that the “chemically engraved” claims are product-by-process claims. We agree with the respondents, however, that those claims are best characterized as pure product claims, since the “chemically engraved” limitation, read in context, describes the product more by its structure than by the process used to obtain it.*

The Office alleges “Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article.”<sup>28</sup> Claims, however, are construed in light of the specification, of which they are a part.<sup>29</sup> The present Specification teaches “[t]he phrase ‘surface finish’ will be used herein to describe the surface of materials on a very fine, or microscopic, scale...”<sup>30</sup> While the drawings of Kobe show enlarged views, and in those views the surfaces of Kobe’s article may appear smooth, Kobe is completely silent with regard to any surfaces being having polished surface finishes, *i.e.*, polished on a microscopic scale, as required by claims 6 and 8-10. Not only must the prior art suggest the claimed invention, the prior art must disclose each and every element of the claimed invention.<sup>31</sup> The cited references, however, fail to meet this standard. Accordingly, claims 6 and 8-10 are allowable over Kobe, Siverson, and Tokas.

#### **E. Claim 7 is separately allowable over the cited references**

Claim 7 requires the polished surface finish of the silicone elastomer to be smooth. The Office relies upon Kobe to teach surface finish limitations of the claimed invention. As discussed above concerning the 35 USC § 112, second paragraph, rejection of claim 7, the surface of the silicone elastomer omits a texture or pattern. Kobe, however, fails to teach or disclose such a limitation. Rather, each of Kobe’s embodiments includes protrusions and, thus, is not smooth in the sense of claim 7.

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<sup>28</sup> *Detailed Action*, p. 8, ll. 9-11.

<sup>29</sup> *Phillips v. AWH Corporation*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005).

<sup>30</sup> *WO 2005/026434*, p. 5, ll. 2-3.

#### **F. Claim 11 is separately allowable over the cited references**

Claim 11 requires the texture to be “an array of upraised dimples,” examples of which are shown in Figure 3. The Office alleges that Kobe’s projections are the claimed dimples.<sup>32</sup> A dimple, for example, is “an indented, hollowed, or depressed area in the surface of something.”<sup>33</sup> Kobe neither depicts nor describes such a structure. Accordingly, the cited references cannot render the present invention, as set forth in claim 11, obvious.

#### **G. Claim 12 is separately allowable over the cited references**

Claim 12 requires the silicone elastomer to have “a matte surface finish.” The Office alleges that Kobe’s silicone elastomer “is deemed to [have] a matte finish since it contains projections.”<sup>34</sup> As discussed above concerning the rejection of claims 6 and 8-10, the present Specification teaches “[t]he phrase ‘surface finish’ will be used herein to describe the surface of materials on a very fine, or microscopic, scale....”<sup>35</sup> Thus, Kobe is silent with regard to its article having matte finish in the same way that Kobe fails to teach or disclose its article having a polished finish.

#### **H. Claim 13 is separately allowable over the cited references**

Claim 13, as amended herein, requires the plastic film to be “a heat stabilized plastic film.” The cited references, whether taken singly or in combination, neither disclose or suggest a heat stabilized plastic film. Accordingly, claim 13 is allowable over the cited references.

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<sup>31</sup> *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

<sup>32</sup> *Detailed Action*, p. 9, ll. 1-2.

<sup>33</sup> See <http://encarta.msn.com/encnet/refpages/search.aspx?q=dimple>.

<sup>34</sup> *Detailed Action*, p. 9, ll. 3-4.

<sup>35</sup> *WO 2005/026434*, p. 5, ll. 2-3.

### **I. Claim 16 is separately allowable over the cited references**

Claim 16 requires “graphical indicia associated with the plastic film.” The Office relies upon Kobe to disclose “the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*).”<sup>36</sup> The cited portion of Kobe discloses:

*The thermoplastic materials may also contain additives, including but not limited fillers, fibers, antistatic agents, lubricants, wetting agents, foaming agents, surfactants, pigments, dyes, coupling agents, plasticizers, suspending agents, hydrophilic/hydrophobic additives, and the like.*

Kobe is describing, in general, the types of additives that its thermoplastic materials may contain. One of ordinary skill in the art would appreciate that these additives are of the type that are added to a batch of material, rather than to create a graphical indicia. While a graphical indicia may comprise pigment or a dye, merely stating that pigment or a dye may be included in its thermoplastic material does not meet the requirement that the prior art teach or suggest all of the claimed limitations. Claim 16 is, therefore, allowable over the cited references.

### **J. Claims 17 and 18 are separately allowable over the cited references**

Claim 17 requires the silicone elastomer to be “tinted.” Claim 18 requires “graphical indicia associated with the silicone elastomer.” In rejecting each of these claims, the Office relies upon Kobe to disclose “the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*).”<sup>37</sup> The cited portion of Kobe, however, is directed to materials of its backing layer, such as backing layer 22, not its elastomeric material.<sup>38</sup>

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<sup>36</sup> *Detailed Action*, p. 9, ll. 13-14 (emphasis in original).

<sup>37</sup> *Detailed Action*, p. 9, ll. 13-14 (emphasis in original).

<sup>38</sup> *Kobe*, col. 5, ll. 51-67, and Figure 1.

Kobe describes elsewhere<sup>39</sup> the characteristics of its elastomeric material. Kobe, however, fails to disclose or suggest in any way that its silicone elastomer may be tinted, as required by claim 17, or any graphical indicia associated with its silicone elastomer, as required by claim 18. Thus, claims 17 and 18 are allowable over the cited references.

**K. The phrases “configured for” and “configured to” in claims 19-24 impart structural limitations and the cited references fail to disclose or suggest the limitations of claims 19-24**

The Office alleges that, in claims 19-24, “the limitations ‘for application on the fingertips of users,’ ‘for application on handheld devices,’ ...and ‘configured to be sewn into fabric’ are deemed to be statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned,” citing MPEP 2111.02.<sup>40</sup> It should be noted that MPEP 2111.02 relates to the effect of limitations in the *preamble* of a claim, not to the effect of limitations such as the limitations at issue here, which are located in the body of a claim.

Each of claims 18-24 recites the phrase “configured for” or “configured to.” MPEP 2111.04 instructs that such phrases (e.g., “adapted to,” “adapted for,” and the like) “may raise a question as to the limiting effect of the language in a claim.”<sup>41</sup> Applicant respectfully asserts that the phrases “configured for” and “configured to” imparts definite, structural limitations to the claimed invention, rather than merely the intended use of the invention. For example, the phrase “configured for application on the fingertips of users” means the film is *structurally* configured for application on the fingertips of users, not merely that the film is used on the fingertips of users.

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<sup>39</sup> Kobe, col. 8, l. 52, through col. 9, l. 63.

<sup>40</sup> Detailed Action, p. 9, l. 17, through p. 10, l. 1.



Moreover, the Office alleges that “it is noted that Kobe’s article is useful in golf clubs, baseball bats, household articles, non-slip walking surfaces, etc....The intended uses of Kobe’s article include Applicant’s intended uses for their film.” The Office is reminded that the prior art must disclose each and every limitation of the claimed invention.<sup>42</sup> Whether Kobe teaches use of its article golf clubs, baseball bats, household articles, non-slip walking surfaces, etc.,” the prior art must teach all of the limitations of the rejected claims, including, for example, the film being configured for application on the fingertips of users, the film being configured for application on a material handling device, *etc.* for the prior art to render the rejected claims obvious. If the prior art fails to disclose each of the limitations in each of claims 18-24, then the obviousness rejection of claims 18-24 is *prima facie* deficient. Applicant respectfully asserts that claims 18-24 are allowable over the cited references.

**L. The Office has failed in its burden to describe how the cited references are applied to claim 25**

While claim 25 is listed in the Detailed Action as being rejected under 35 USC § 103(a) over Kobe, Siverson, and Tokas, the Office has failed in its burden to describe how the cited references are applied to claim 25. The burden includes showing an objective teaching in the cited art that would lead one of ordinary skill in the art to combine the teachings of references.<sup>43</sup> If not “readily apparent,” the examiner must explain why the combination of references is proper.<sup>44</sup> No such explanation is provided. Applicant respectfully asserts that the cited references, whether taken singly or in

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<sup>41</sup> See MPEP 2111.04 and *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).

<sup>42</sup> *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

<sup>43</sup> *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).

combination, fail to disclose or suggest “a label stock having graphical indicia adhered to the plastic film, such that the graphical indicia is visible,” as required by claim 25. Accordingly, claim 25 is allowable over the cited references.

Therefore, it is respectfully requested that the rejection of claims 1-25 under 35 USC § 103(a), as being unpatentable over Kobe in view of Siverson and Tokas, be reconsidered and withdrawn.

## **VI. NEW CLAIMS**

Claims 36-40 have been added. Independent claim 36 is drawn to a silicone elastomer film comprising, *inter alia*, “a heat-stabilized, plastic film.” As discussed above, Siverson is not available as prior art in the present Application. Even so, as discussed above concerning the 35 USC § 103(a) rejection of claim 13, Kobe, Siverson, and Tokas, taken singly or in combination, fail to disclose or suggest this limitation. Claims 37-39 depend from claim 36 and are, thus, allowable over Kobe, Siverson, and Tokas. Independent claim 40 also requires “a heat-stabilized, plastic film” and is, thus, allowable over Kobe, Siverson, and Tokas. Moreover, claim 40 requires a silicone elastomer layer “defining a plurality of dimples extending outwardly from an exposed surface of the silicone elastomer layer.” Accordingly, claim 40 is further allowable over Kobe, Siverson, and Tokas for at least the same reasons set forth above concerning claim 11. Other distinctions over the cited references, however, may exist.

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<sup>44</sup> *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1790 (Bd. Pat. App. & Int. 1987).

## **CONCLUSION**

Applicant's arguments and amendments are made without prejudice or disclaimer. Distinctions from the various references cited by the Office have been discussed by Applicant. Other distinctions, however may exist. Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Office, Applicant does not acquiesce to the Office's additional statements. Applicant's response is sufficient to overcome the Office's rejections.

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 578-8616 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date

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